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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,331	01/02/2004	Andrew R. Heiges	9974-34-5054-01-US	7616

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MORGAN LEWIS & BOCKIUS LLP  
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WASHINGTON, DC 20004

EXAMINER
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SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3692

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/751,331		HEIGES ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Narayanswamy Subramanian		3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This office action is in response to applicants' original application filed on January 2, 2004, and the communication filed on July 21, 2004. Replacement drawings filed by the applicants on July 21, 2004 are accepted by the examiner. Claims 1-8 are currently pending in the application and have been examined. The objections and rejections are stated below.

#### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claims 1 and 5 recite “a computerized method for illustrating and analyzing college savings plans” and “a system for illustrating and analyzing college savings plans” respectively. However it is not clear at which step of the method claim or using what means of the system claim the objective of illustrating college savings plans is realized. Claims 2-4 and 6-8 are rejected for similar reasons and also because they depend on a rejected claim. Appropriate clarification/correction is required.

Claims 2 and 6 recite the limitation “wherein at least one of the educational savings plans is a Section 529 Plan developed pursuant to Section 529 of the U.S. Internal Revenue Code”. The limitation specifying a Section 529 of the U.S. Internal Revenue Code renders the claim indefinite. Section 529 is a code, which periodically is updated with changes and therefore makes it transitory-in-nature. Upon each update of the Section 529 code, the scope of the instant application would be altered and would be transitory-in-nature as well. Consequently the Section 529 limitation without a set-in-stone definition renders the metes and bounds of the claim confusing.

Continuing, the specification is a written description of the invention and of the manner and process of making and using the same. The specification must be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention pertains to make and use the same. See 35 U.S.C. 112 and 37 CFR 1.71. If a newly filed application obviously fails to disclose an invention with the clarity required by 35 U.S.C. 112, revision of the application should be required. See MPEP § 702.01. Referencing Section 529, which is transitory-in-nature, ensures that the scope of the specification is altered with each update of the Section 529 code, and thus the specification is not considered to be full, clear,

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concise and exact terms as to enable any person skilled in the art to comprehend. Claims 3-4 and 7-8 are rejected for similar reasons and also because they depend on a rejected claim.

Appropriate clarification/correction is required.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

Claims 1 and 5 recite the steps of “(a.) receiving at least one educational institution identifier; (b.) for each of the educational institution identifiers received in step (a), retrieving the corresponding cost parameter set from the computer-readable medium; (c.) generating a comparative analysis of a plurality of educational savings plans by applying each of the retrieved cost parameter sets of step (b) to each of the plurality of educational savings plan parameters”. These steps are nothing more than inputting data and manipulation of data. There is no "real world" result necessarily produced. The final result of generating a comparative analysis of a plurality of educational savings plans is broad enough to cover mere thoughts, which are abstract.

The Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). These decisions explained that, to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and

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tangible result.” State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601 02. To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways: (a) The claimed invention “transforms” an article or physical object to a different state or thing. (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107.

The tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application”).

For an invention to produce a “concrete” result, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable.

There is no useful, concrete and tangible result produced from implementing the steps of the claimed invention. Claims 2-4 and 6-8 are rejected for the same reason and by way of dependency on a rejected independent claim.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yinbal (US Patent 6,424,952 B1).

Claims 1 and 5, Yinbal discloses a computerized method and system for illustrating and analyzing college savings plans, the method for use with a computer-readable medium (See Yinbal Column 10 lines 8-18, a computer-readable medium is inherent in the disclosure) on which are stored a plurality of educational institution identifiers and a plurality of educational savings plan parameter sets, each of respective educational institution identifiers being associated with a corresponding cost parameter set specifying at least one of room, board, and tuition costs for the respective educational institution; each of the plurality of educational savings plan parameters specifying one or more financial characteristics of a corresponding educational savings plan; the method comprising the steps of: a. receiving at least one educational institution identifier (See Yinbal Figure 1, Column 2 line 65 – Column 3 line 46); b. for each of the educational institution identifiers received in step (a), retrieving the corresponding cost parameter set from the computer-readable medium (See Yinbal Figure 1, Column 4 lines 13-65); c. generating a comparative analysis of a plurality of educational savings plans by applying each of the retrieved cost parameter sets of step (b) to each of the plurality of educational savings plan

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parameters (See Yinbal Figure 1, Column 10 line 61 – Column 11 line 15). Yinbal does not explicitly teach the limitation of “wherein the comparative analysis takes into account one or more taxation implications for at least one of the educational savings plans”. However this limitation is not given patentable weight because the limitation of taking into account one or more taxation implications for at least one of the educational savings plans has not been positively recited.

Claims 2-4 and 6-8, Yinbal does not explicitly teach the features wherein at least one of the educational savings plans is a Section 529 Plan developed pursuant to Section 529 of the U.S. Internal Revenue Code; generating a comparative analysis further includes comparing each of a plurality of educational savings plans with reference to one or more specific asset allocations and applying a Section 529 Plan asset allocation to all assets, so as to provide a comparison based upon tax considerations.

Official notice is taken that the features wherein at least one of the educational savings plans is a Section 529 Plan, comparing plans with reference to one or more specific asset allocations and applying tax considerations to asset allocation for all assets are old and well known. These features help parents in making informed decisions about saving for their children’s education based on their individual preferences and circumstances.

It would have been obvious to one of ordinary skill in the art at the time of invention to include this feature to the invention of Yinbal. The combination of disclosures suggested that parents would have benefited from making informed decisions about saving for their children’s education based on their individual preferences and circumstances.



### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Jones et al. (US Patent 7,016,870 B1) (March 21, 2006) Identifying a Recommended Portfolio of Financial Products for an Investor based upon Financial Products that are available to the Investor.

(b) Purcell, Jr. (US Patent 5,727,161) (March 10, 1998) Method and Analysis of Variation of Economic Plans.

(c) Fleming (US Patent 4,787,036) (November 22, 1988) Student Enrollment Stabilization System.

(d) Rebane (US 6,405,179 B1) (June 11, 2002) System and Method for Data Collection, Evaluation, Information Generation, and Presentation.

(e) Crapo (US Patent 5,987,433) (November 16, 1999) Method and System for Developing a Time Horizon Based Investment Strategy.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "N. Sub", followed by a long horizontal line extending to the right.

Dr. N. Subramanian  
Primary Examiner  
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March 15, 2007